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09/613,615 07/11/00 NEOFYTIDES

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| EXAMINER |
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TM02/1011

MORRIS, MANNING & MARTIN, LLP
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE ROAD, N.E.
ATLANTA GA 30326

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2164
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/613,615

Applicant(s)

NEOFYTIDES, Cheryl L. et al

Examiner

Jim Calve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 11, 2000

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-29 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

18) ☒ Interview Summary (PTO-413) Paper No(s). 6

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the length of the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 18, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 17 and 28 are vague and indefinite. It is unclear whether claims 17 and 28, which recite a “computer-readable medium having computer-executable instructions for performing the method of claim 1 [19]”, respectively, are intended to be independent claims, in which case the particular structural or functional limitations intended to be encompassed thereby (i.e., the metes and bounds of claims 17 and 28) are unclear, or whether claims 17 and 28 depend from claims 1 and 19, respectively, in which case, claims 17 and 28 fail to further limit the subject matter of claims 1 and 19, which recite a “computer-implementable method.”

b. Claims 18 and 29 are vague and indefinite. It is unclear whether claims 18 and 29, which recite a “computer system adapted to perform the method of claim 1 [19]”, respectively, are intended to be independent claims, in which case the particular structural or functional limitations intended to be encompassed thereby (i.e., the metes and bounds of claims 18 and 29)

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are unclear, or whether claims 18 and 29 depend from claims 1 and 19, respectively, in which case, claims 18 and 29 fail to further limit the subject matter of claims 1 and 19, which recite a "computer-implementable method."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-3, 6, 11, 16-18, 19, 20, 21, 24, 25, 28, and 29, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lamm, U.S. patent 6,078,907.

Lamm discloses a computer-implementable method for providing a computer network money request service, including maintaining an e-mail address database (e.g., EPO server 16) (Figure 1; column 5, line 10 et seq; column 6, line 53 et seq; column 8, line 55 et seq; column 9, line 15 et seq), receiving an e-mail address of a payee from a payor and completing payment if the database contains the payee's e-mail address (e.g., column 6, line 53 et seq; column 7, line 14 et seq; column 9, line 62 et seq; column 11, line 17 et seq; column 15, line 30 et seq; column 15, line 63 et seq; column 16, line 19 et seq; column 16, line 48 et seq), receiving an e-mail address of an individual payor from a payee (e.g., column 8, line 56 et seq; column 9, line 58 et seq; column 11, line 17 et seq), sending an e-mail to the payor (e.g., Figure 5; column 11, line 58 et seq; column

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12, line 8 et seq; column 14, line 40 et seq), receiving authorization and completing payment (e.g., column 15, line 10 et seq; column 15, line 30 et seq).

Lamm also discloses first and second intermediary banks and transfer methods (e.g., column 16, line 33 et seq), default money receipt selection method (e.g., column 4, line 23 et seq), notifying payee of payment (e.g., column 16, line 19 et seq), initiating money transfer and crediting a stored value account (e.g., column 16, line 48 et seq), receiving future payment dates to transfer money (e.g., column 9, line 40 et seq; column 15, line 10 et seq; column 15, line 45 et seq), online transaction history statements (e.g., column 16, line 5 et seq), e-mail link to web page to authorize payment (e.g., column 15, line 30 et seq; cf., column 8, line 64 et seq; column 11, line 30 et seq), including individual message/subject line in e-mail (e.g., column 11, line 30 et seq; column 12, line 55 et seq; column 13, line 15 et seq).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Wolff, U.S. patent 6,247,047.

Lamm discloses a computer-implementable method for providing a computer network money request service, including first and second intermediary banks and payment transfer methods (e.g., column 16, line 33 et seq), as discussed. To the extent that Lamm does not

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disclose payment authorization by a second individual (e.g., via ATM or private payment network) (e.g., column 16, line 44 et seq), Wolff discloses a computer-implementable method for providing a computer network, including maintaining an e-mail database (e.g., column 6, line 53 et seq; column 7, line 7 et seq; column 11, line 40 et seq; column 12, line 31 et seq), receiving an e-mail address from a first individual and searching the e-mail database (e.g., column 11, line 25 et seq), and notifying the second individual by e-mail to receive authorization to receive payment (e.g., Figures 1-4; column 11, line 40 et seq; column 12, line 10 et seq). E-mail notification provides an improved means to facilitate computer network transactions by permitting individuals to control receipt of payment (e.g., Wolff, column 4, line 34 et seq; column 11, line 40 et seq; column 12, line 10 et seq) among various payment methods (e.g., Lamm, column 16, line 33 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a means for a second individual to authorize payments and thereby control transfer of money to various accounts, as taught by Wolff, on the method of Lamm to facilitate commerce on computer networks among a plurality of individuals and payment methods.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Dorf, U.S. patent 6,189,787.

Lamm discloses a computer-implementable method for providing a computer network money request service, including payment through an intermediary bank. Lamm does not disclose a point of sale transaction with a debit card. Dorf discloses a computer-implementable method for providing a computer network money request service, including a debit card (e.g., Figure 1) and point of sale terminal for debiting a stored value account to pay a merchant through an

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intermediary bank (e.g., Figures 1, 2; column 1, line 15 et seq; column 3, line 15 et seq; column 11, line 5 et seq). Debit and multi-use cards facilitate commerce in point-of-sale transactions by providing a means to transfer value to a merchant in exchange for goods or services (e.g., column 1, line 8 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a debit card, as taught by Dorf, on the method of Lamm to facilitate point-of-sale transactions and value transfers therefor.

9. Claims 8, 9, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Payne et al, U.S. patent 5,909,492.

Lamm discloses a computer-implementable method for providing a computer network money request service, including searching an e-mail database for addresses of parties to a person-to-person payment service, as discussed. Lamm does not disclose registration of individuals whose e-mail addresses do not exist in the database. Payne et al disclose a computer-implementable method for providing a computer network money request service, including identification of individuals by network addresses and other identifiers (e.g., Figures 2A-2I; column 5, line 26 et seq), sending a registration message to unregistered individuals to register and authorize payment (e.g., column 5, line 57 et seq; column 6, line 9 et seq) and web page link (e.g., column 6, line 15 et seq) to register and complete payment. Providing for new account registration facilitates money request service and payment transactions by registering new individuals during payment processing (e.g., column 6, line 15 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for new account registration, as taught by Payne et al, on the method of Lamm to permit payors and payees (cf.,

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MPEP 2144.04 VI (regarding reversal or rearrangement of parts)) to open new accounts and complete funds transfer.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Payne et al, U.S. patent 5,909,492, as applied to claim 8 above, and further in view of Kausik et al, U.S. patent 6,263,446.

The modified method of Lamm discloses a computer-implementable method for providing a computer network money request service, including authentication (e.g., Lamm, column 9, line 27 et seq) and registration (e.g., Payne et al; column 5, line 57 et seq; column 6, line 9 et seq) of individuals involved in payment transactions. The modified method of Lamm does not disclose shared-secret authentication. Kausik et al disclose a computer-implementable method for providing a computer network transaction service (e.g., Figure 1; column 3, line 10 et seq), including user authentication via a shared secret (e.g., column 4, line 1 et seq). Shared-secret authentication provides an improved means to identify an individual involved in a network transaction (e.g., column 2, line 10 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate individuals involved in network transactions through the use of shared secrets, as taught by Kausik et al, on the method of Lamm to facilitate payments therebetween. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention, based on the teachings of Kausik et al to establish a shared secret between individuals involved in a money payment transaction to authenticate the respective parties prior to payment.

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11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Dent et al, U.S. patent 6,128,603.

Lamm discloses a computer-implementable method for providing a computer network money request service, including payment of money on a future date, as discussed (e.g., column 15, line 10 et seq; column 15, line 45 et seq). Lamm does not disclose a graphical calendar interface and pointing device for selecting future payment dates. Dent et al disclose a computer-implementable method for providing a computer network money request service, including providing a graphical calendar interface and pointing device to select future payment dates (e.g., Figures 6, 7; column 8, line 8 et seq). A graphical calendar interface provides a simplified means for a person to schedule payments of money to other individuals (e.g., column 9, line 5 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a graphical calendar interface, as taught by Dent et al, on the method of Lamm to facilitate payment scheduling.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Kitchen et al, U.S. patent 6,289,322.

Lamm discloses a computer-implementable method for providing a computer network money request service, including payment of money on a future date, as discussed (e.g., column 15, line 10 et seq; column 15, line 45 et seq). Lamm does not disclose receipt of payment frequency and duration data. Kitchen et al disclose a computer-implementable method for providing a computer network money request service, including receipt of frequency and duration of payment information to repeat payments (e.g., Figures 9C, 10A; column 14, line 33 et seq).

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Frequency and duration of payment information provides a convenient means for individuals to schedule future payments of money (e.g., column 14, line 45 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide future payment date information, as taught by Kitchen et al, on the method of Lamm to facilitate future payments.

13. Claims 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Robertson, U.S. patent 6,269,369.

Lamm discloses a computer-implementable method for providing a computer network money request service, including searching an e-mail database for addresses of parties to a person-to-person payment service, as discussed. Lamm does not disclose an address book. Robertson discloses the use of an address book as a means to facilitate personal contacts over a computer network (e.g., column 8, line 64 et seq; column 9, line 10 et seq). A virtual address book provides an improved identification means to facilitate person-to-person transactions over a computer network (e.g., column 2, line 46 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an online address book, as taught by Robertson, on the method of Lamm to facilitate identification of network users with whom an individual wants to interact.

14. Claims 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm, U.S. patent 6,078,907, in view of Bernstein, U.S. patent 5,915,023.

Lamm discloses a computer-implementable method for providing a computer network money request service, including remote access over a computer network (e.g., Figures 1-6), as discussed. Lamm does not disclose a wireless transaction device. Bernstein discloses a

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computer-implementable method for providing computer network money request service using e-mail identifiers (e.g., column 3, line 64 et seq; column 4, line 5 et seq) and wireless devices (e.g., Figures 1-6; column 2, line 55 et seq; column 11, line 42 et seq). Wireless transaction devices facilitate commercial transactions and payments using existing communications networks (e.g., column 2, line 32 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide wireless transaction devices, as taught by Bernstein, on the method of Lamm to facilitate commerce and payments services over existing public communications networks.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Jalili, U.S. patent 6,088,683 discloses network payment with e-mail messaging.
- b. Goldsmith, U.S. patent 6,064,990 discloses e-mail messaging for tracking account activity.
- c. Neely, U.S. patent 6,044,362 discloses a payment service with e-mail messaging and user authorization.
- d. Burns et al, WO 00/46725 disclose a network payment system with e-mail.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can be reached on Monday through Friday from 6:45 am to 6:45 pm. The official fax number of the

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organization is 703-746-7239. Any inquiry of a general nature should be directed to the receptionist at 703-305-3900.

Respectfully submitted,

A handwritten signature in cursive script that reads "Jim Calve".

Jim Calve
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October 5, 2001